REMARKS

Claim 44 is cancelled. Claims 1, 7 and 40 have are currently amended. Claims 1-43 and 45-50 remain in the application for consideration. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

§§ 102 and 103 Rejections

Claims 1-2, 4-5, 12-15, 18, 21-23, 25, 29-30, 33, 37-41 and 43 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,929,849 to Kikinis (hereafter "Kikinis").

Claims 3, 6-11, 16-17, 19-20, 24, 26-28, 31-32, 34-36, 42 and 44-50 stand rejected under U.S.C. §103(a) as being unpatentable over Kikinis in view of WIPO Patent No. WO96/10888 to Adams et al. (hereinafter "Adams").

Claims Rejected over Kikinis under §§ 102 and 103

Claim 1 has been amended and recites a method comprising the following steps [added language appears in bold italics]:

- transmitting a video stream; and
- formatting supplemental data files in a graphical markup language, each supplemental data file having instructions for rendering a hyperlink overlay on the video stream, *wherein formatting comprises setting transparent areas of each hyperlink overlay to a key color*;
- transmitting the supplemental data files along with the video stream.

In making the rejection, the Office argues that Kikinis anticipates the subject matter in the claim. Specifically, the Office states: "'each supplemental

data file having instruction for rendering over on the video stream' reads on the executing the 'Dynamic URL' by a browser to render over the video stream as shown on Fig. 2C (see Fig. 3A, el. 87 and 91; Col. 8, lines 5-37)". Applicant respectfully disagrees and traverses the Office's rejection.

In Applicant's previous response filed August 9, 2004, Applicant submitted that the Office had mischaracterized *this claim element* by substituting actual claim language "...*for rendering a hyperlink overlay on the video stream;*" with different language: "...*for rendering over on the video stream*". Applicant further explained that Kikinis discloses the rendering of a Dynamic URL, specifically as a downloaded webpage in a superimposed window. (See, e.g. Kikinis, column 8 lines 13-15). This superimposed window does not *render a hyperlink overlay* on the video stream, as that term is understood in the context of Applicant's disclosure. Instead, the window is superimposed *on top of* the underlying video display, as illustrated in Kikinis Fig. 2C (which shows a webpage and other entities *occluding* the video/TV display directly behind it).

Nonetheless, Applicant has amended this claim to include *"wherein formatting comprises setting transparent areas of each hyperlink overlay to a key color"*. Applicant submits that neither Kikinis nor Adams, either singly or in combination, teach or suggest "setting transparent areas of each hyperlink overlay to a key color", as claimed.

Accordingly, for at least the reasons given above, this claim is allowable.

Claims 2-15 depend from claim 1 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 1, are neither disclosed nor suggested in the references of record, either singly or in combination with one

another. In addition, given the allowability of claim 1, the rejection of claims 3 and 6-11 over the combination with Adams is not seen to add anything of significance.

Claim 16 recites a method comprising the following steps [emphasis added]:

- transmitting a video stream; and
- formatting HTML files having instructions for rendering hyperlink pages on a video stream, the *hyperlink pages having transparent areas that are set to a key color*; and
- associating the HTML files with the video stream; and
- *displaying the hyperlink pages on a display*; and
- displaying the video stream on the display in areas of *displayed hyperlink pages that are set to a key color.*

In making out the rejection of this claim, the Office argues that the combination of Kikinis and Adams discloses the subject matter of this claim. Specifically, the Office merely argues that its analysis in respect to claims 1-3 and 5 suffices to support the rejection.

Applicant is confused as to how the Office's analysis in claims 1-3 and 5 is relevant to this claim. For instance, claims 1-3 and 5 do not expressly recite: "formatting HTML files having instructions for rendering hyperlink pages on a video stream, the *hyperlink pages having transparent areas that are set to a key color;*" or "displaying the video stream on the display in areas of *displayed hyperlink pages that are set to a key color.*" Applicant respectfully submits that the Office has improperly expressed this rejection, as described by MPEP 707.07(d).

MPEP 707.07(d) states that "[a] plurality of claims should never be grouped together in a common rejection, unless the rejection is equally applicable to all claims in the group." In addition, Applicant respectfully submits that the pertinence of Kikinis and Adams has not been explained. MPEP 707.05 states that "[w]hen such prior art is cited, its pertinence should be explained." Applicant therefore requests that the examiner clearly communicate the basis for this rejection.

Nevertheless, Applicant submits that the cited references do not teach or suggest all features of this claim. For instance, in Applicant's previous response filed August 9, 2004, Applicant explained that neither Kikinis nor Adams disclose or suggest "hyperlink pages having *transparent areas* that are set to a *key color*", as claimed. In response, the Office disagrees, but rather than explaining the pertinence of Kikinis or Adams, it merely cites specific portions of Adams. Applicant submits that these excerpts merely indicate that an associated data stream may be carried "via a chrominance key" and that command functions may determine how the video/audio stream and any associated objects are ultimately displayed. While these *functions* may include "ordering of graphic text items for layering on the screen", "Background: transparent...", or "Foreground: visible/invisible", Applicant fails to see how this discloses or suggests "formatting HTML files having instructions for rendering hyperlink pages on a video stream, the *hyperlink pages having transparent areas that are set to a key color*" or "displaying the video stream on the display in areas of *displayed hyperlink pages that are set to a key color*". Furthermore, Applicant submits that the "chrominance key" mentioned in Adams is merely one of several means of transferring an associated data stream and is not implicated in such a way as to

disclose the subject matter of this claim. For instance, Applicant directs the Office's attention to Adams page 6, lines 9-12 and page 20, lines 15-17, which are reproduced below [emphasis added]:

> Another object of the present invention is to provide an interactive video system that employs the vertical blanking intervals of the video frames of a video signal or chrominance, sideband, or audio sub carrier signals *to transfer the associated data stream.*

> For other embodiments, *the associated data stream is carried via* a chrominance key, a sideband transmission, or an audio sub carrier.

Finally, Applicant reminds the Office that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. (*In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); see also MPEP 2143). Here, Adams and Kikinis contain no such suggestion or motivation. Furthermore, Applicant respectfully reminds the Office that it bears the burden of explaining "why the combination of the teachings is proper" (MPEP 2142). Here, no such explanation has been proffered by the Office. In this regard, the Office's stated motivation regarding claim 3 is not relevant because the subject matter recited of claim 3 is not expressly recited in this claim.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness and has made an improper rejection. Hence, for at least these reasons, this claim is allowable.

Claims 17-23 depend from claim 16 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 16, are neither disclosed nor suggested in the references of record, either singly or in combination with one another.

Claim 24 discloses a method comprising the following steps [emphasis added]:

- receiving a video stream; and
- associating one or more *hyperlink pages* with the video stream, the *hyperlink pages having transparent areas that are set to a key color*; and
- displaying the hyperlink pages on a display; and
- *displaying the video stream on the display in areas of displayed hyperlink pages that are set to a key color*.

In making out the rejection of this claim, the Office argues that the combination of Kikinis and Adams discloses the subject matter of this claim. Specifically, the Office argues that its analysis in respect to claims 1-3, 5 and 7 suffices to support the rejection. Specifically, in regards to claim 7, the Office argues that "Adams discloses the step of setting transparent areas of each associated graphic/text items overlay to a key color (page 20, lines 18-page 21, lines 10), the displaying step comprises displaying the video stream only in the areas of the hyperlink overlays that are set to a key color (page 23, lines 10-page 24, lines 10)." The Office then argues that it would have been obvious to modify Kikinis with Adams "so as to enable the receiver to define windows according to the specifications provided by the associated data to display received video data stream within the defined windows (page 22, lines 10-page 23, lines 2)."

Applicant respectfully disagrees and traverses the Office's rejection. Applicant submits the cited references do not teach or suggest all features of this claim and the Office has mischaracterized the Adams reference. Specifically, the cited excerpt on pages 20-21 merely indicates that an associated data stream may be carried "via a chrominance key" (one of several means of transferring an associated data stream) and lists an embodiment of the command protocol containing commands that perform a list of functions. However, nothing discusses "hyperlink pages having transparent areas that are set to a key color", as the Office contends. Similarly, the cited excerpt on pages 23-24 discusses characteristics of associated data packets and commands associated with them, but does not disclose or suggest "the displaying step comprises displaying the video stream only in the areas of the hyperlink overlays that are set to a key color", as the Office contends.

Finally, as discussed above, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. (*In re Jones*; see also MPEP 2143). Here, Adams and Kikinis contain no such suggestion or motivation. Furthermore, as noted above, the Office bears the burden of explaining "why the combination of the teachings is proper." (MPEP 2142). Here, the Office's only attempt at such an explanation is to state that one would have been motivated "so as to enable the receiver to define windows according to the specifications provided by the associated data to *display received video data stream within the defined windows*". The Office cites Adams in support of this statement which merely describes functionality of Adams and fails to explain *why* the combination is proper. (Adams, page 22, line 24 – page 23, line 3, states: "the video driver routines 108 enable the client runtime manager 102 to

display the incoming video data stream within the video window 40 on the display surface 50 of the display device 12.")

As an aside, the Office has provided a paper, available at the following link:

http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm

that describes proper and improper rejections made under §103(a). Particularly instructive is a portion that appears in Section IV of the paper which provides guidance in regards to communicating a proper §103(a) rejection. The pertinent part of this paper is reproduced below for the Office's convenience:

IV. Communicating the Rationale for a Proper Rejection under 35 U.S.C. 103

When an examiner rejects a claim as failing to meet one or more of the statutory requirements for patentability, administrative due process and 35 U. S.C. 132 require that applicant be adequately notified of the reasons for the rejection of the claim so that applicant can decide how to proceed. The statutory requirement that an Office action state the reasons for any rejection is critical to proper action taking.

In writing a rejection under 35 U.S.C. 103, the examiner should <u>appropriately communicate</u>:

(1) the particular part of a reference being relied upon should be designated as nearly as practicable; 37 CFR § 1.104(c)(2);
(2) the differences between the claimed invention and the closest prior art;
(3) where the differences are found or suggested in the prior art;
(4) how the teachings of the prior art are combined; and
(5) *why the combination of those teachings would have been obvious to one of ordinary skill in the art at the time the invention was made. <u>Do not recite the disclosure of the prior art which reads on the claimed invention as the motivation.</u> Communicate why the references themselves, the knowledge of one of ordinary skill in the art, or the nature of the problem to be solved establishes a motivation to combine the prior art references.*

Once applicant has presented rebuttal evidence, examiners should reconsider any initial obviousness determination in view of the entire record. All the proposed rejections and their bases should be reviewed to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the Office's findings and conclusions, *articulating how the conclusions are supported by the findings*.

Here, as discussed above, the Office's stated motivation merely recites the disclosure of Adams and is unacceptable, as demonstrated by the Office's own guidance given above.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness and has made an improper rejection. Hence, for at least these reasons, this claim is allowable.

Claims 25-31 depend from claim 24 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 24, are neither disclosed nor suggested in the references of record, either singly or in combination with one another.

Claim 32 discloses a computer-readable storage medium having computer-executable instructions for performing steps comprising [emphasis added]:

- receiving a video stream; and
- associating one or more hyperlink pages with the video stream, *the hyperlink pages having transparent areas that are set to a key color*; and
- displaying the hyperlink pages on a display; and
- *displaying the video stream on the display in areas of displayed hyperlink pages that are set to a key color.*

In making out the rejection of this claim, the Office argues that the combination of Kikinis and Adams disclose the subject matter of this claim. Specifically, the Office argues that the Office's analysis in respect to claims 1-3, 5 and 7 suffices to support the rejection.

Applicant respectfully disagrees and traverses the Office's rejection. As discussed above, the cited references do not teach or suggest "hyperlink pages having transparent areas that are set to a key color" or "displaying the video stream on the display in areas of displayed hyperlink pages that are set to a key color", as claimed. Additionally, the references contain no suggestion or motivation to combine the teachings of Adams with Kikinis and the Office fails to explain *why* the combination is proper.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness and has made an improper rejection. Hence, for at least these reasons, this claim is allowable.

Claims 33-39 depend from claim 32 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 32, are neither disclosed nor suggested in the references of record, either singly or in combination with one another.

Claim 40 has been amended and recites a video broadcast system comprising [added language appears in bold italics]:

- a broadcast source that broadcasts a video stream and provides accompanying supplemental data files, each supplemental data file having instructions for rendering a hyperlink overlay on the video stream; and

- a receiver configured to receive the video stream and accompanying supplemental data files and to display the hyperlink overlays in conjunction with the video stream, *wherein the receiver comprises color keying hardware that displays video only in display areas that are set to a key color, the hyperlink overlays having transparent areas that are set to a key color*.

In making out the rejection of claim 40, the Office argues that supplemental data files having instructions for "rendering a *hyperlink* overlay on the video stream" reads on the Dynamic URL notoriously known in the computer art with CGI extension or Script with coded syntax in different format. The Office refers to column 8, lines 5-18 and column 10, lines 18-25, of Kikinis and argues that its system must be formatted at the server/headend with such a file. The Office also argues that Kikinis (as illustrated in Fig. 1, 2C, and 3A) discloses "a receiver configured to receive the video stream and accompanying supplemental data file and to *display the overlays* in conjunction with the video stream. "

In Applicant's previous response filed August 9, 2004, Applicant respectfully disagreed and submitted that Kikinis' superimposed window does not render a *hyperlink overlay* on the video stream, as the term "hyperlink overlay" is used and defined in Applicant's specification, and, in point of fact, teaches directly away therefrom.

Nonetheless, Applicant has amended this claim to include *"wherein the receiver comprises color keying hardware that displays video only in display areas that are set to a key color, the hyperlink overlays having transparent areas that are set to a key color"*. Applicant submits that neither Kikinis nor Adams, either singly or in combination, teaches or suggest "setting transparent areas of each hyperlink overlay to a key color", as claimed.

Accordingly, for at least the reasons given above, this claim is allowable.

Claims 41-43 depend from claim 40 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 40, are neither disclosed nor suggested in the references of record, either singly or in combination with one another. In addition, given the allowability of claim 40, the rejection of claim 42 over the combination with Adams is not seen to add anything of significance.

Claim 45 recites a receiver for receiving and displaying video streams, comprising [emphasis added]:

- display hardware for displaying video streams and bit-mapped images to a user; and
- the display hardware including *color keying hardware that displays video in display areas that are set to a key color*; and
- access means for reading supplemental data files that have instructions for rendering *bit-mapped hyperlink overlays in conjunction with the video stream at indicated times*; and
- a data processor that reads the supplemental data files and in response displays the *hyperlink overlays* at the indicated times, wherein the *hyperlink overlays have transparent areas that are set to a key color, the hyperlink overlays thus appearing to overlay the video streams*.

In making out the rejection of this claim, the Office argues that the combination of Kikinis and Adams discloses the subject matter of this claim. The Office first argues that Kikinis discloses a step of transmitting supplemental data files (Dynamic URLs) to display *hyperlink overlays* as discussed in claim 1. Applicant respectfully disagrees, and as discussed above, submits that Kikinis discloses the rendering of a Dynamic URL specifically as a downloaded webpage

in a *superimposed* window and does not disclose or suggest rendering *hyperlink overlays*, as understood in the context of Applicant's disclosure.

The Office also argues that Adams discloses display hardware, as recited in this claim, including "color–keying hardware that displays video in display areas that are set to a key color", and cites Fig. 2, el. 56. The Office states that page 20, lines 18-page 21, lines 10, disclose "wherein the overlays have transparent areas that are set to a key color; the overlays thus appearing to overlay the video streams". The Office then reasons that it would have been obvious to modify Kikinis with Adams "so to enable the receiver to define windows according to the specifications provided by the associated data to display received video data stream within the defined windows (page 22, lines 10-page 23, lines 2)."

Applicant respectfully disagrees and traverses the Office's rejection. Applicant respectfully submits these excerpts do not teach or suggest all features of this claim and that the Office has mischaracterized the Adams reference. Specifically, nothing in the Adams reference teaches that Fig. 2, el. 56 includes "color–keying hardware that displays video in display areas that are set to a key color. Additionally, as discussed above, the cited excerpt on pages 20-21 merely indicates that an associated data stream may be carried "via a chrominance key" (one of several means of transferring an associated data stream) and lists an embodiment of the command protocol containing commands that perform a list of functions. However, nothing discloses "wherein the overlays have transparent areas that are set to a key color; the overlays thus appearing to overlay the video streams", as the Office contends.

In summary, neither reference discloses or suggests *"color keying hardware* that displays video *in display areas that are set to a key color"*, *bit-*

mapped hyperlink overlays in conjunction with the video stream at indicated times, displaying the *"hyperlink overlays* at the indicated times", or *"hyperlink overlays having transparent areas that are set to a key color, where the hyperlink overlays thus appear to overlay the video streams",* as claimed. Hence, for at least these reasons, this claim is allowable.

Finally, there is no suggestion or motivation in Adams or Kikinis to combine these teachings, and the Office's only stated motivation is that one would have been motivated "so as to enable the receiver to define windows according to the specifications provided by the associated data to *display received video data stream within the defined windows*". As noted above, this statement merely describes functionality of Adams and fails to explain *why* the combination is proper. Therefore, as demonstrated by the Office's own guidance, this stated motivation is unacceptable.

In view of the above discussion, the Office has not established a *prima facie* case of obviousness and has made an improper rejection. Hence, for at least these reasons, this claim is allowable.

Claims 46-50 depend from claim 45 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 45, are neither disclosed nor suggested in the references of record, either singly or in combination with one another. In addition, given the allowability of claim 45, the rejection of claims 46-50 over the combination with Adams is not seen to add anything of significance.

Conclusion

All of the claims are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

Dated: 6/10/05   By: _____
                              Lance R. Sadler
                              Reg. No. 38,605
                              (509) 324-9256